

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

32410

Hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name Robert F. Bodi

Application Number

09/505,810

Filed

February 17, 2000

First Named Inventor

Kyoko Kawaguchi

Art Unit

1762

Examiner

Alain L. Bashore

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

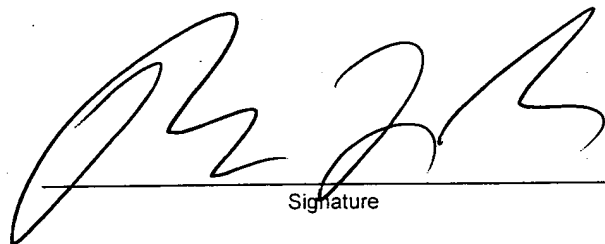
attorney or agent of record: 48,540

Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


SignatureRobert F. Bodi

Typed or printed name

216/579-1700

Telephone number

12/19/05

Date

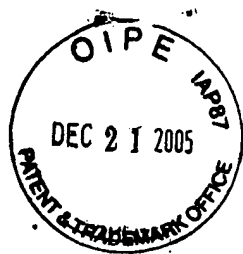
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Appln. No. 09/505,810
Response. Dated December 19, 2006
Reply to Office Action of November 18, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kyoko Kawaguchi, et al.
Appln. No. : 09/505,810
Filed : February 17, 2000
Title : ELECTRONIC ASSET UTILIZATION SYSTEM, ELECTRONIC ASSET
UTILIZATION METHOD, SERVER FOR USE WITH ELECTRONIC
ASSET UTILIZATION SYSTEM, AND RECORDING MEDIUM
HAVING RECORDED THEREON ELECTRONIC ASSET
UTILIZATION METHOD

Conf. No. : 7331
TC/A.U. : 1762
Examiner : Alain L. Bashore

Customer No. : 000,116
Docket No. : 32410

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

**REMARKS/ARGUMENTS SUPPORTING THE
PRE-APPEAL BRIEF CONFERENCE**

Claims 3-8, 48, 54-55, 78-82 and 84-90 were again rejected under 35 U.S.C. §103(a) as being unpatentable over DeLapa *et al.* (U.S. 6,076,068) in view of Stumm (U.S. 5,768,528) and Walker (U.S. 6,240,396). Claims 9-13, 22, 54, and 72-83 were again rejected as being unpatentable as above in further view of Hughes. For the following reasons, the rejections are traversed.

As previously argued, claim 84 recites (with emphasis added) “means for *electronically* sending an order for purchasing an *electronic asset* including *electronic data* for obtaining a service or product being offered for sale by a vendor” and “an exchange certificate issuance section for *electronically* transmitting an *exchange certificate* including *electronic data* to said first terminal or to a second terminal in response to said order, wherein said exchange certificate is used for verifying a user's right to receive said electronic asset”

and wherein “said exchange certificate includes information about obtaining said electronic asset” and further wherein “said electronic asset is for obtaining the service or product from the vendor.” Claims 85–87 and 89 recite similar limitations. The cited references do not teach these elements of the claims, as has been argued repeatedly in this case.

The Examiner, yet again, improperly cites the *paper coupon* of DeLapa as teaching the “exchange certificate” of the claims. This is an unreasonable interpretation of both the claims and the reference. As argued at least twice previously, the *paper coupon* of the reference is nothing more than a custom printed coupon used in a manner that any discount coupon is used (see abstract). The coupon is printed on *paper* (see col. 7, lines 59–67), and is used at a point-of-sale to obtain a discount on a product purchase (see col. 5, lines 55–65). Thus, the reference teaches that this coupon is a physical piece of paper with matter printed thereon. There is absolutely nothing “electronic” about it.

In particular, there is no teaching or suggestion that this paper coupon includes any “electronic data”, or is “electronically transmitted”, as specifically recited in the claims, because the coupon of DeLapa, as pointed out above, is a *paper* coupon, and there is absolutely no teaching that this coupon can be “electronically transmitted”, and any such suggestion that such a paper coupon is an exchange certificate, as specifically defined in the claim, is ludicrous and unreasonable.

Perhaps the Examiner is instead referring to the “targeted coupon records” described in col. 7 of the reference. Those records are taught as passing through a communication network such as a public telephone system (see col. 7, lines 47–53). However, these records are merely for the purpose of printing the paper coupons, and thus provide only the information necessary to print the coupon itself (see col. 7, lines 59–65). In no case can these records be considered an “exchange certificate” as recited in the claims, because these records are not an “exchanged” for anything, but instead are merely that data necessary for printing the desired paper coupons.

Furthermore, the resulting DeLapa printed paper coupon does not represent an “electronic asset”, as that term is understood in the art, because the coupon is printed on paper, and thus is not “electronic”. And the “records” discussed above are certainly not an asset, as they merely have data necessary for printing the coupon. The data itself is not even a coupon, let alone an asset.

In fact, the reference fails to teach any electronic asset at all! Despite previously filed protests, the Examiner, yet again, has not pointed to exactly what element in DeLapa is supposed to teach the “electronic asset” of the invention. The coupon itself clearly cannot be cited as *both* the exchange certificate *and* the electronic asset. At most, DeLapa suggests obtaining a *product* directly, with additional payment, when using the paper coupon for a discount to purchase the product. There is no teaching of an *exchange* of any electronic exchange certificate for any *electronic asset* which is then used to obtain a service or product, as required by the claim language, anywhere in the reference.

In response to these arguments provided in previous filings, the Examiner merely cites a long section of the reference as teaching a “user’s right to receive an electronic asset”, but the Examiner fails to point out specifically what element found in this section supposedly teaches the “electronic asset”. However, a detailed review of that section (col. 4, line 20 to col. 5, line 31) does not show any teaching of exchanging the “coupon” for any “electronic asset”. Thus, the reference does not teach the cited claim elements as limited by the claim language. Instead, the Examiner just repeats the same sections over and over, without pointing out the specific features of the reference that supposedly teach the claim elements, merely responding to applicants’ arguments that “there is disclosed to Walker the electronic transmittance of certificates that confer rights”. What about DeLapa? This fails to address any of the issues raised by the previously filed arguments. The Examiner does not address these previously raised issues.

Similarly, the Examiner appears to also rely on Walker for teaching an exchange certificate and electronic asset of the claims. The problems with the Walker reference being cited for teaching such claim elements were discussed in detail in an appeal brief filed in this case. Note that this appeal led to a withdrawal of the previous rejections based based on Walker, and resulted in the Examiner providing the DeLapa reference. There is no need to repeat those arguments here, as the examiners are specifically referred to pages 10-12 of the appeal brief filed on October 30, 2003, where this reference was discussed in detail, obviously with success as the previous rejections were withdrawn. There, the argument makes clear that Walker does *not* teach the exchange certificate and electronic asset as limited by the claim language. By adding the DeLapa reference, the prosecution of this case was not furthered, as one bad reference was merely substituted for another bad reference, at enormous expense to applicant.

Furthermore, claim 84 recites that the exchange certificate is used for “verifying a user's right to receive said electronic asset.” Claims 85–87 and 89 recited similar limitations. In contrast, the paper coupon of DeLapa does not provide any *right* to receive anything. It merely provides a discount for a product purchase. The product must still be purchased, and thus the coupon provides only a discount. Furthermore, it is clear that the paper coupon of DeLapa is to be used for purchasing an product, not exchanged for an electronic asset (of which there is no suggestion at all).

Stumm, Walker, Sasmazel and Hughes all fail to overcome the shortcomings of DeLapa. Thus, for any of the above reasons, claims 84–87 and 89 are patentable over the reference. The remaining claims depend on one or more of claims 84–87 and 89, and thus are patentable over the references for the same reasons.

As discussed above, in response to these previously provided arguments, the Examiner's sole argument is that there is “disclosed to (sic) Walker the electronic transmittance of certificates that confer rights.” (See last paragraph of page 4 of the current Office action). With all due respect, this is not a proper response to the previously filed arguments, which point out numerous gaps in the Examiner's reasoning that have never been properly addressed by the Examiner. The Examiner, yet again, fails to address the specifically identified problems with the Examiner's interpretation of the prior art, and specific claim limitations that are not taught in any of the references. Applicant has put much time in reviewing the references and pointing out the shortcomings, and yet the examiner has done little to support his positions in this case other than to cite long sections of the reference, without pointing out specifically what teachings are being relied on. The Examiner's responses, in fact, are nothing more than repeated copies of the same material, over and over again without clarification.

The Examiner has also failed to provide the proper motivation for combining the references. The Examiner's arguments for adding references are nothing more than the generalized *benefits* of their teachings. It is not proper to merely rely on a general benefit of a teaching for adding that teaching to another reference. If such were considered proper motivation, then every reference would be self-motivating, and thus every invention based on new combinations of known elements would be obvious because such an argument can always be applied to any such new combination. Clearly, this is not legally proper.

Accordingly, the rejections for obviousness are not supported by the Office Action and thus the rejection is improper, and should be withdrawn.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32410.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: December 19, 2006